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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,821	11/24/2003	Douglas B. Wilson	114089.120	5355

23483 7590 12/15/2004

WILMER CUTLER PICKERING HALE AND DORR LLP
60 STATE STREET
BOSTON, MA 02109

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,821

Applicant(s)

WILSON, DOUGLAS B.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

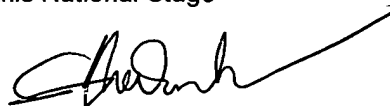
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 23, 2004 has been entered.

2. Claims 1-19 are objected to because of the following informalities: the claims contain typographical errors. For example, the recitation "body at" in line 6 of claim 1 should have been "at" and "decrete" in line 7 of claim 10 should have been "discrete." Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether a confusing variety of terms such as "a predetermined peripheral portion" in claim 1 and "a predetermined portion" in claim 7 refer to the same or different things. See MPEP § 2173.05(o).

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6, 8-19, and claim 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (US Patent No. 4,708,676 cited in the first Office action on June 23, 2004).

Regarding claim 1, Lin teaches a fatigue relieving/preventing apparatus associated with a vehicular control means 2 comprising:

a first section (unnumbered, see Attachment) that connects to a predetermined peripheral portion of the vehicular control means 2; and

a deformable section 22 that connects to and extends from, the first section (Att.) at the predetermined peripheral portion of the vehicular control means 22, the deformable section 22 for supporting at least a portion of a vehicular operator's body (Fig. 7) with the deformable section 22 being deformable by the vehicular operator so that the deformable section 22 is substantially out of interference with the vehicular operator's ability to operate the vehicular control means 2.

Claim 1 and other claims below are anticipated by Lin because Lin teaches each and every positive claimed element and its functional limitation. On the one hand, Lin's section 22 is an air chamber, thus, it is deformable. On the other hand, note that virtually anything will be deformed if enough pressure is applied to it. See the term "flexible" in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

Regarding claim 2, the deformable second section 22 is deformable in at least one direction when deforming pressure is applied to such deformable second section 22.

Regarding claim 3, the deformable second section 22 supports a portion of the vehicular operator's body (Fig. 7) when pressure from such body portion is applied in at least one direction.

Regarding claim 4, the vehicular control means 2 is capable of controlling at least a nautical vessel. *Id.*, col. 1, lines 11-47.

Regarding claim 5, the deformable second section 22 will return to an original first position after deforming pressure is removed therefrom.

Regarding claim 6, the portion of the body supported by the deformable second section 22 includes at least a hand (Fig. 7).

Regarding claim 7, the first section (Att.) extends a length of a predetermined portion of the vehicular control means 2.

Regarding claim 8, the deformable second section 22 includes at least two deformable second sections (Fig. 7) that each connect to the first section (Att.).

Regarding claim 9, the first section (Att.) is deformable since it is made of an elastic material, i.e., PVC (polyvinylchloride). *Id.*, col. 3, lines 42-49.

Regarding claim 10, Lin teaches a fatigue relieving/preventing apparatus associated with a vehicular control means 2, comprising:

at least two discrete first sections (Att.) that each connect to a predetermined peripheral portion of the vehicular control means 2, and

a discrete deformable second section 22 that connects to and extends from, each first section (Att.) at the predetermined peripheral portion of the vehicular control means 2, the discrete deformable second section 22 for supporting at least a portion of a vehicular operator's body with each deformable second section 22 being deformable by the vehicular operator so that the deformable section 22 is substantially out of interference with the vehicular operator's ability to operate the vehicular control means 2.

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Regarding claim 11, each deformable second section 22 is deformable in at least one direction when deforming pressure is applied to each discrete such deformable second section 22.

Regarding claim 12, each deformable second section 22 supports a portion of the vehicular operator's body when pressure from such body portion is applied to it in at least one direction.

Regarding claim 13 the vehicular control means 2 is capable of controlling at least a nautical vessel (Fig. 7).

Regarding claim 14, each deformable second section 22 will return to an original first position after deforming pressure is removed therefrom.

Regarding claim 15, the portion of the body supported by the deformable second section 22 includes at least a hand.

Regarding claim 16, the apparatus is adjustable for supporting different sizes or types of body portions (by, *e.g.*, deflating or inflating the air in the chamber 22).

Regarding claim 17, each first section (Att.) is capable of being formed integral with the vehicular control means 2. On the other hand, it has long been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

Regarding claim 18, each first section 22 is capable of being detached from the vehicular control means 2 as seen in Fig. 6. See also *In re Hutchison, supra*.

Regarding claim 19, each first section 22 is deformable since it is made of an elastic material, *i.e.*, PVC (polyvinylchloride). *Id.*, col. 3, lines 42-49. See also *Fredman v. Harris-Hub Co., Inc.*, *supra*.

7. Claims 1-6, 8-19, and claim 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Dickerson (US Patent No. 4,875,386).

Regarding claim 1, Dickerson teaches a fatigue relieving/preventing apparatus associated with a vehicular control means 14 comprising:

a first section 20 that connects to a predetermined peripheral portion of the vehicular control means 14; and

a deformable section 18 that connects to and extends from, the first section 20 at the predetermined peripheral portion of the vehicular control means 14, the deformable section 18 for supporting at least a portion of a vehicular operator's body (Fig. 1) with the deformable section 18 being deformable by the vehicular operator so that the deformable section 18 is substantially out of interference with the vehicular operator's ability to operate the vehicular control means 14.

Claim 1 and other claims below are anticipated by Dickerson because Dickerson teaches each and every positive claimed element and its functional limitation. On the one hand, Dickerson's section 18 is made of a resilient material such as plastic (*id.*, col. 3, lines 10-12), it is deformable. On the other hand, note that virtually anything will be deformed if enough pressure is applied to it. See the term "flexible" in *Fredman v. Harris-Hub Co., Inc.*, *supra*.

Regarding claim 2, the deformable second section 18 is deformable in at least one direction when deforming pressure is applied to such deformable second section 18.

Regarding claim 3, the deformable second section 18 supports a portion of the vehicular operator's body (Fig. 1) when pressure from such body portion is applied in at least one direction.

Regarding claim 4, the vehicular control means 14 is capable of controlling at least a ground transportation vehicle.

Regarding claim 5, the deformable second section 18 will return to an original first position after deforming pressure is removed therefrom.

Regarding claim 6, the portion of the body supported by the deformable second section 18 includes at least a hand (Fig. 1).

Regarding claim 7, the first section 20 extends a length of a predetermined portion of the vehicular control means 14.

Regarding claim 8, the deformable second section 18 inherently includes at least two deformable second sections that each connect to the first section (one second section is for the right hand grip 14 and another second section is for the left hand grip 14. The use of right and left fatigue relieving apparatus is conventional as seen in, e.g., US Patent No. 3,937,629 issued to Hamasaka).

Regarding claim 9, the first section 20 is deformable since it is made of an elastic material. *Id.*, col. 3, lines 10-12.

Regarding claim 10, Dickerson teaches a fatigue relieving/preventing apparatus associated with a vehicular control means 14, comprising:

at least two discrete first sections 20 that each connect to a predetermined

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peripheral portion of the vehicular control means 2 (one first section is for the right hand grip 14 and another first section is for the left hand grip 14. The use of right and left fatigue relieving apparatus is conventional as seen in, e.g., US Patent No. 3,937,629 issued to Hamasaka), and

a discrete deformable second section 18 that connects to and extends from, each first section 20 at the predetermined peripheral portion of the vehicular control means 14, the discrete deformable second section 18 for supporting at least a portion of a vehicular operator's body with each deformable second section 18 being deformable by the vehicular operator so that the deformable section 18 is substantially out of interference with the vehicular operator's ability to operate the vehicular control means 14.

Regarding claim 11, each deformable second section 22 is deformable in at least one direction when deforming pressure is applied to each discrete such deformable second section 22.

Regarding claim 12, each deformable second section 18 supports a portion of the vehicular operator's body when pressure from such body portion is applied to it in at least one direction.

Regarding claim 13 the vehicular control means 14 is capable of controlling at least a ground transportation vehicle (Fig. 1).

Regarding claim 14, each deformable second section 18 will return to an original first position after deforming pressure is removed therefrom.

Regarding claim 15, the portion of the body supported by the deformable second section 18 includes at least a hand.

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Regarding claim 16, the apparatus is adjustable for supporting different sizes or types of body portions. *Id.*, col. 4, lines 9-19.

Regarding claim 17, each first section 20 is capable of being formed integral with the vehicular control means 14. On the one hand, the term “integral” is sufficient broad to embrace construction united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326 (CCPA); *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997). On the other hand, it has long been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison, supra*.

Regarding claim 18, each first section 20 is capable of being detached from the vehicular control means 14. See also *In re Hutchison, supra*.

Regarding claim 19, each first section 20 is deformable since it is made of an elastic material. *Id.*, col. 3, lines 10-12. See also *Fredman v. Harris-Hub Co., Inc., supra*.

8. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hamasaka (US Patent No. 3,937,629).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gemma (apparatus 10).

10. Applicant's arguments filed November 23, 2004 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-19 based on Raudebaugh (US Patent No. 3,884,092) have been considered but are moot in view of the new ground(s) of rejection.

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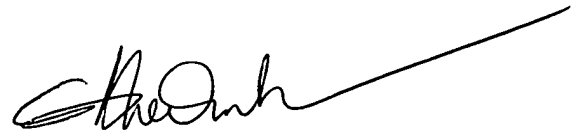
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

December 9, 2004

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong
Primary Examiner

ATTACHMENT

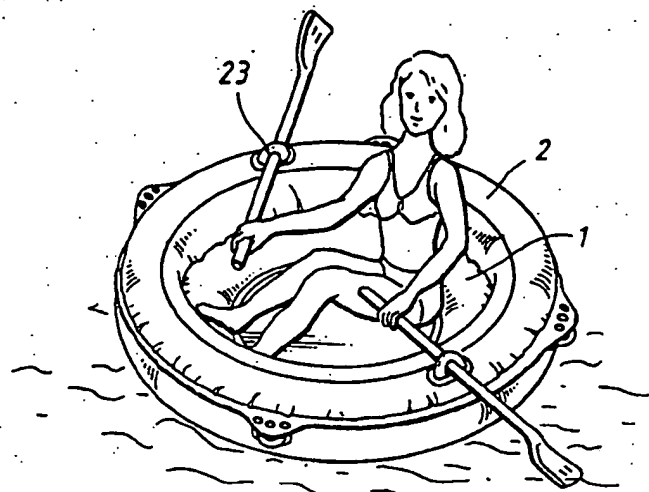


FIG. 6

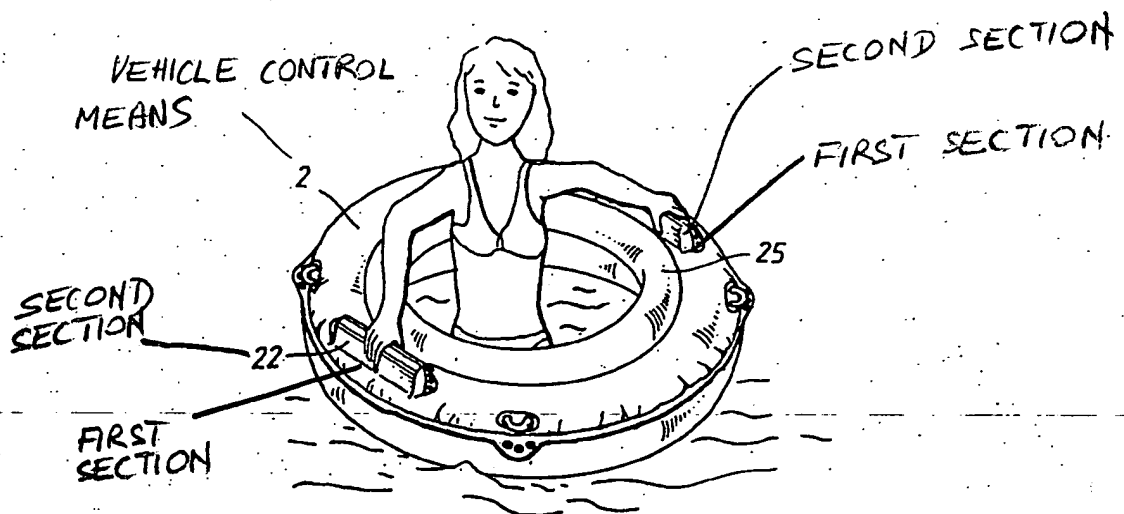


FIG. 7